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EXAMINER

USTARIS, JOSEPH G

ART UNIT

PAPER NUMBER

2616

DATE MAILED: 08/03/2004

7

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/732,203

Applicant(s)

PHILIPS, ASHWIN

Examiner

Joseph G Ustaris

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Specification***

1. The abstract is objected to because of the following informalities:
  - The abstract uses legal phraseology such as "means". Please revise the abstract's contents in order to meet the proper format of an abstract.

Appropriate correction is required.

### ***Double Patenting***

2. Applicant is advised that should claim 10 be found allowable, claim 26 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). The examiner will assume that claim 26 is dependent off claim 25.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3-5, 7, 8, 11-18, 20-24, and 27-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Russo (US006025868A).

Regarding claim 1, Russo discloses a stored program pay-per-play system for "storing, playing and downloading audio/video tracks" (See column 3 lines 5-35). The system has a "means for connecting to a communications network" to record or "download" media programs or "audio/video tracks" (See Fig. 1 element 2; column 3 lines 50-53), a "means for receiving, over said communications network, availability information identifying audio/video tracks that are available for purchase", and a "means for displaying said availability information" where the user can select available programs to be recorded or "downloaded" and will be charge once the program has been viewed/heard (See column 9 line 61 – column 10 line 24). Inherently, the user has a "means for inputting a user selection of an audio/video track from said availability information, so as to obtain a selected audio/video track" by using the hand-held remote (See Fig. 2 element 163; column 9 lines 43-44). Once the user has made a selection the system proceeds to record or "download" and stores the selected programs or "a means for downloading the selected audio/video track over the communications network" and "a means for storing the selected audio/video track downloaded" (See column 10 lines 4-11; column 4 lines 15-25). The system inherently has a "means for reading the selected audio/video track from" the high-capacity storage and a "means for playing the selected audio/video track...so as to generate an audio/video signal" in order to provide the "audio/video signal" to a television or monitor or "home stereo

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system” for the user to enjoy (See Fig. 2 elements 110, 112, 118, 120, and 126; column 10 line 58 – column 11 line 13).

Regarding claim 3, the system utilized a high-capacity storage that is a disk drive or “permanent storage device” (See Fig. 2 element 110).

Regarding claim 4, the high-capacity storage disk drive is also known as “a hard disk drive” (See claim 3 above).

Regarding claim 5, the media programs recorded or “downloaded” are “automatically stored” in the high-capacity storage device (See column 4 lines 28-35).

Regarding claim 7, the pay-per-play system has a “means for displaying audio/video tracks available on” the high-capacity storage (See column 5 lines 55-60 and column 10 lines 58-65), where the user can browse the contents in a similar manner used to selected the programs to be recorded or “downloaded” or “displaying availability information and displaying downloaded audio/video tracks available...in a substantially identical manner” (See column 10 lines 63-67).

Regarding claim 8, the user is inherently able to “navigate through availability information” in order to make a selection (See column 10 lines 1-5).

Claim 11 contains the limitations of claim 7 and 8 (where the user can browse the contents in a similar manner used to selected the programs to be recorded or “downloaded” or “permit navigation in a substantially identical manner”) and is analyzed as previously discussed with respect to those claims. Furthermore, the user is able to “navigate through the tracks available on” the high-capacity storage (See column 10 lines 58-65).

Regarding claim 12, the user inherently inputs their selection through a remote hand-held unit or "wireless remote control" (See column 9 lines 43-44 and column 10 lines 60-64).

Regarding claim 13, the high-capacity storage "stores the selected audio/video track in an encrypted format, and further comprising decryption means for decrypting the selected audio/video track" (See column 4 lines 28-35).

Regarding claim 14, the system is able to de-scramble the signal during playback or "decrypts the selected audio/video track on-the-fly during playback" (See column 4 lines 28-35).

Regarding claim 15, the system is also able to send a key specifically addressed to the decoder to de-scramble an encrypted program or "using a decryption key that is uniquely associated with said apparatus" (See column 6 lines 19-23).

Regarding claim 16, the cable converter box is inherently "driven by software" in order to successfully carry out its functions (See Fig. 2). Furthermore, the software of the cable converter box allows the user to utilize VCR-like controls while viewing the media program or "wherein user modification of the software driving said apparatus is limited to defined option choices" (See column 6 lines 6-15).

Regarding claim 17, the system has a "means for providing a video signal to a home television set" in order to display information (See Fig. 1 and column 3 lines 56-62).

Claim 18 contains the limitations of claims 1 and 16 and is analyzed as previously discussed with respect to those claims.

Claim 20 contains the limitations of claims 3 and 18 and is analyzed as previously discussed with respect to those claims.

Claim 21 contains the limitations of claims 4 and 20 and is analyzed as previously discussed with respect to those claims.

Claim 22 contains the limitations of claims 5 and 20 and is analyzed as previously discussed with respect to those claims.

Claim 23 contains the limitations of claims 7 and 18 and is analyzed as previously discussed with respect to those claims.

Claim 24 contains the limitations of claims 8 and 18 and is analyzed as previously discussed with respect to those claims.

Claim 27 contains the limitations of claims 11 and 24 and is analyzed as previously discussed with respect to those claims.

Claim 28 contains the limitations of claims 12 and 18 and is analyzed as previously discussed with respect to those claims.

Claim 29 contains the limitations of claims 13 and 18 and is analyzed as previously discussed with respect to those claims.

Claim 30 contains the limitations of claims 14 and 29 and is analyzed as previously discussed with respect to those claims.

Claim 31 contains the limitations of claims 15 and 29 and is analyzed as previously discussed with respect to those claims.

Claim 32 contains the limitations of claims 17 and 18 and is analyzed as previously discussed with respect to those claims.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 9, 19, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Russo (US006025868A) in view of Srinivasan (US 20020062357A1).

Claim 2 contains the limitations of claim 1 and is analyzed as previously discussed with respect to that claim. However, Russo does not disclose that the "communications network is an Internet".

Srinivasan discloses a pay-per-record system where the user is able to download music, video, and software over a communications network. The server is able to distribute the music, video, and software over the worldwide web or "Internet" (See Fig. 1 and paragraph 0018). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify communications network disclosed by Russo to include the "Internet", as taught by Srinivasan, in order to be able to reach a wider range of customers using different communications networks.

Regarding claim 9, Russo in view of Srinivasan allows that user to browse "based on different category types", i.e. software, music, and movies (See Srinivasan paragraph 0025).



Claim 19 contains the limitations of claims 2 and 18 and is analyzed as previously discussed with respect to those claims.

Claim 25 contains the limitations of claims 9 and 24 and is analyzed as previously discussed with respect to those claims.

Claims 10 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Russo (US006025868A) in view of Srinivasan (US 20020062357A1) as applied to claims 2, 9, 19, and 25 above, and further in view of Proehl et al. (US006690391B1).

Regarding claim 10, Russo in view of Srinivasan does not disclose that the user can browse "through availability information based on different categories within said different category types".

Proehl et al. (Proehl) discloses a graphic user interface used for navigation and selection of audio/video information within an audio/vided system. The user is able to select a category, i.e. music, and then select a sub-category, i.e. Jazz, or "different categories within said different category types" (See Fig. 7 and Fig. 12). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the user interface disclosed by Russo in view of Srinivasan to allow the user to browse "through availability information based on different categories within said different category types", as taught by Proehl, in order to make browsing more efficient for the user thereby providing more convenience.

Claim 26 contains the limitations of claims 10 and 25 and is analyzed as previously discussed with respect to those claims.

Claims 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Russo (US006025868A) in view of Perlman (US006530085B1).

Claim 6 contains the limitations of claim 1 and is analyzed as previously discussed with respect to that claim. However, Russo does not disclose the cable converter box "comprises a RCA jack".

Perlman discloses a system and method for interconnecting terminals or cable boxes to a television (See column 1 lines 5-15). In one embodiment, the terminal includes RCA jacks to connect the terminal to the television using A/V cables (See Fig. 4). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the cable converter box disclosed by Russo to include RCA jacks, as taught by Perlman, in order to improve video quality of information flowing from the cable converter box to a television.

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please take note of Katz et al. (US 20020059363A1) for their similar method of distributing media over the Internet.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Ustaris whose telephone number is (703) 305-

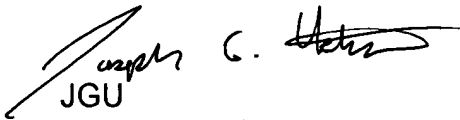
0377. The examiner can normally be reached on Monday-Friday with alternate Fridays off from 7:30 A.M. to 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile, can be reached on (703) 305-4380. The fax phone number for this Group is (703) 872-9306.

Any inquiry of general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 305-4700.



VIVEK SRIVASTAVA  
PRIMARY EXAMINER



JGU  
July 19, 2004